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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,222	12/19/2001	Jerry Pelletier	073406-0701	4998

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EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,222

Applicant(s)

PELLETIER ET AL.

Examiner

David J Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-104 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 48-104 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of the Application

- [1] Claims 48-104 are pending in the application.
- [2] Applicant's amendment to the specification in Paper No. 4, filed June 03, 2002, is acknowledged.
- [3] Applicant's cancellation of claims 1-47 and addition of claims 48-104 in Paper No. 14, filed July 9, 2003, is acknowledged.
- [4] Receipt of Information Disclosure Statements filed as Paper Nos. 11 and 12 is acknowledged. The information disclosure statements fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The examiner has made an earnest attempt to locate the missing references without success. The information disclosure statements have been placed in the application file, but the information referred to therein has not been considered.
- [5] It is noted that claim 65 depends from canceled claim 12 and claim 77 depends from canceled claim 29. In the interest of advancing prosecution and for purposes of restriction, claim 65 has been interpreted as being dependent upon claim 48 and claim 77 is interpreted as being dependent upon claim 76. It is noted that if applicant intends for claims 65 and 77 to be dependent upon claims other than those stated above, a supplemental restriction may be necessary.

Election/Restrictions

- [6] Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 66-72 and 84-91, drawn to an isolated, purified or enriched bacterial polypeptide and a composition comprising a first polypeptide and a second polypeptide, classified in class 435, subclass 194.
 - II. Claims 92-95, drawn to an isolated polynucleotide, a recombinant vector, and a recombinant host cell, classified in class 435, subclass 252.3.

- III. Claims 65 and 96-102, drawn to an antibacterial agent and a method of making an antibacterial compound, classified in class 514, subclass 789.
- IV. Claims 48-54, drawn to a method for identifying a compound that potentially binds to a STAAU_R9 polypeptide, classified in class 435, subclass 7.1.
- V. Claims 55-58, drawn to a method for identifying a potential antibacterial agent by determining whether a test compound inhibits binding between a bacteriophage polypeptide and a bacterial primase polypeptide, classified in class 435, subclass 7.1.
- VI. Claims 59-64, drawn to a method for identifying a potential antibacterial agent by determining whether a test compound inhibits or reduces the biological activity of an *S. aureus* DnaG primase, classified in class 435, subclass 15.
- VII. Claims 73-80, 103, and 104, drawn to a method for inhibiting a bacterium, classified in class 435, subclass 252.1.
- VIII. Claims 81-83, drawn to a method for treating or preventing a bacterial infection in a mammal, classified in class 514, subclass 789.

[7] The inventions are distinct, each from the other because:

[8] The polynucleotide of Group II, the polypeptide of Group I, and the antibacterial agent of Group III each comprises a chemically unrelated structure capable of separate manufacture, use and effect. The polynucleotide of Group II has other utility besides encoding polypeptides such as a hybridization probe and the polypeptide of Group I can be made by a method other than polynucleotide expression such as purification from the natural source or chemical synthesis.

[9] The polypeptide of Group I and the methods of Groups IV-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group I can be used as an antigen in the production of an antibody.

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[10] The polypeptide of Group I is unrelated to the method(s) of Group VII and VIII as it is neither used nor made by the method(s) of Groups VII and VIII.

[11] The polynucleotide of Group II is unrelated to the method(s) of Groups IV-VIII as it is neither used nor made by the method(s) of Groups IV-VIII.

[12] The antibacterial agent of Group III and the methods of Groups IV-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibacterial agent of Group III, particularly the antibacterial agent of claim 100, can be used as antigen in the production of an antibody to the polypeptide of SEQ ID NO:4.

[13] The methods of Group IV-VIII are independent as they comprise different steps, utilize different products and/or yield different results.

[14] MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, each of the inventions of Groups I-VIII are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. Each of the inventions requires a separate patent and non-patent literature search requiring a different text and/or sequence search for each Group and thus, co-examination of the inventions of Groups I-VIII would be a serious burden on the examiner.

[15] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[16] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named

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inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman
Patent Examiner
Art Unit 1652

DS 08/09/03